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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/518,926   | 12/23/2004  | Makoto Ishikawa      | 1422-0655PUS1       | 7260             |
| 2292   | 7590        | 04/10/2008           | EXAMINER            |                  |
| BIRCH STEWART KOLASCH & BIRCH<br>PO BOX 747<br>FALLS CHURCH, VA 22040-0747 |             |                      |                     | KUGEL, TIMOTHY J |
| ART UNIT   |             | PAPER NUMBER         |                     |                  |
| 1796   |             |                      |                     |                  |
| NOTIFICATION DATE  |             | DELIVERY MODE        |                     |                  |
| 04/10/2008   |             | ELECTRONIC           |                     |                  |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

|                              |                        |                     |  |
|------------------------------|------------------------|---------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |  |
|                              | 10/518,926             | ISHIKAWA ET AL.     |  |
|                              | <b>Examiner</b>        | <b>Art Unit</b>     |  |
|                              | Timothy J. Kugel       | 1796                |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 26 February 2008.

2a) This action is **FINAL**.                            2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-4 and 6 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-4 and 6 is/are rejected.

7) Claim(s) 6 is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.

4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.

5) Notice of Informal Patent Application

6) Other: \_\_\_\_\_.

**DETAILED ACTION**

1. Claims 1-4 and 6 are pending as amended on 26 February 2008, claims 5 and 7-10 being cancelled.
2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 26 February 2008 has been entered.
3. The text of those sections of Title 35, US Code not included in this action can be found in a prior Office action.

***Response to Arguments***

4. Applicant's arguments, filed 26 February 2008, particularly that US Patent 6,193,986 (Sakurada hereinafter) teaches a water-in-oil emulsion rather than an oil-in-water emulsion as instantly claimed has been fully considered and is persuasive. However, upon further consideration, a new ground of rejection is made below.

The rejection of claims 1-4 and 6 under 35 USC § 103(a) as being unpatentable over US Patent 6,193,986 (Sakurada hereinafter) in view of International Patent Application Publication WO 01/58279 (Takahashi hereinafter) has been withdrawn.

***Double Patenting***

5. Applicant is advised that should claim 4 be found allowable, claim 6 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim.

See MPEP § 706.03(k).

***Claim Rejections - 35 USC § 103***

6. Claims 1-6 are rejected under 35 USC § 103(a) as being unpatentable over US Patent 6,193,986 (Sakurada hereinafter) in view of US Patent 4,379,755 (Yamada hereinafter) and in further view of International Patent Application Publication WO 01/58279 (Takahashi hereinafter). US Patent Application Publication 2003/0035859 is the US equivalent to Takahashi and all references herein are taken therefrom.

Sakurada teaches a foodstuff (Column 1 Lines 5-13) comprising an water-in-oil emulsion (Column 1 Lines 14-33) wherein the oily phase comprises 0.5 to 50% of an emulsifier (Column 6 Lines 16-18)—including hexaglycerol trioleate and sucrose fatty acid esters as exemplified in the instant specification alone of in combination (Column 4 Line 53 – Column 5 Line 31)—and an oily component—including arachidonic acid, eicosapentaenoic acid and docosahexaenoic acid (Column 5 Line 47 – Column 5 Line 15).

Sakurada does not disclose expressly such a composition in an oil-in-water composition.

Yamada discloses an emulsion for use in cosmetics or food wherein the emulsion is of the oil-in-water type (Column 1 Lines 16-60) comprising a sucrose fatty-acid ester emulsifier.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to produce the Sakurada foodstuff as an oil-in-water emulsion as taught by Yamada. The rationale to do so would have been the motivation provided by Yamada that such emulsions are much desired over water-in-oil types as they have superior feel and homogeneity (Yamada Column 1 Lines 37-43 and 67-60).

Neither Sakurada nor Yamada disclose expressly the use of sucrose acetate butyrate as an emulsifying agent.

Takahashi discloses that sucrose acetate isobutyrate is an equivalent emulsifying agent to the sucrose fatty acid esters taught by Sakurada (¶0029).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to include the sucrose acetate isobutyrate emulsifying agent of Takahashi in the composition of Sakurada. The rationale to do so would have been the teaching of Takahashi that sucrose acetate isobutyrate is a functional equivalent to sucrose fatty acid esters. Further, it has been held that it is *prima facie* obviousness to use a known material based on its suitability for its intended use (*Sinclair & Carroll Co. v. Interchemical Corp.*, 325 US 327, 65 USPQ 297 (1945), *In re Leshin*, 227 F2d 197, 125

USPQ 416 (CCPA 1960) and *Ryco, Inc. v. Ag-Bag Corp.*, 857 F2d 1418, 8 USPQ2d 1323 (Fed Cir 1988)).

***Conclusion***

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Timothy J. Kugel whose telephone number is (571) 272-1460. The examiner can normally be reached 6:00 AM – 4:30 PM Monday - Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

8. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Timothy J. Kugel/  
Patent Examiner, AU 1796